



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

APPLICANTS: Michael Knowles
TITLE: DEMAND-BASED PROVISIONING FOR A MOBILE
COMMUNICATION DEVICE
SERIAL NO.: 10/663,582
FILING DATE: September 16, 2003
EXAMINER: not yet assigned
GROUP ART UNIT: 2681
ATTORNEY DOCKET NO.: 555255012416

HON. ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

PETITION TO MAKE SPECIAL UNDER 37 CFR § 1.102

In accordance with 37 CFR § 1.102(d) and MPEP § 708.02(VIII), applicant hereby petitions to make the above referenced application special. The Assistant Commissioner is hereby authorized to charge any fees required for the proper filing of this Petition, including the fee of \$130 under 37 CFR § 1.17(h), to the Jones Day Deposit Account No. 501432, order 555255012416.

Regarding the requirements set forth in MPEP § 708.02(VIII)(B), applicant contends that all claims, as amended by the concurrently filed Preliminary Amendment, are directed to a single invention. If the Office determines that all the claims presented are not obviously directed to a single invention, then applicant will make an election without traverse.

Regarding the requirements set forth in MPEP § 708.02(VIII)(C) and (D), applicant encloses herein a copy of a European Search Report from European Patent Application No. 03020958.9, which is the European counterpart of the present application. In the European Search Report, US Patent No.

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CLI-1235613v1

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450


on Oct. 13, 2004

By: Julia Pexan

6,564,055 was deemed most closely related to the subject matter of the present application. A copy of US Patent No. 6,564,055 is enclosed herein.

Regarding the requirements of MPEP § 708.02(VIII)(E), a detailed discussion of the most closely related reference, US Patent No. 6,564,055, is set forth in the written opinion section of the enclosed European Search Report. In particular, paragraph 3 of the written opinion section of the European Search Report indicates that the subject matter of original method claim 10 is novel and inventive over the prior art. System claim 1 has been amended, as suggested by the European Search Report, to include limitations consistent with the corresponding method claim 10. Specifically, claim 1 has been amended by Preliminary Amendment to require that the provisioning server be operable to "determine if the stored service information has previously been transmitted to the mobile communication device, and if the stored service information has not previously been transmitted to the mobile communication device, then encapsulate the service information in a service update data message and transmit the service update data message to the mobile communication device." As recognized by the European Search Report, the prior art of record does not include this feature.

Respectfully submitted,



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JDRP - Munich 138
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Frist:
Bearb.: EEER

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Zeichen/Ref./Réf.

J100159EP MR

Anmeldung Nr./Application No./Demande n°/Patent Nr./Patent No./Brevet n°.

03020958.9-1249-

Anmelder/Applicant/Demandeur/Patentinhaber/Proprietor/Titulaire

Research In Motion Limited

COMMUNICATION

The European Patent Office herewith transmits as an enclosure the European search report for the above-mentioned European patent application.

If applicable, copies of the documents cited in the European search report are attached.

☒ Additional set(s) of copies of the documents cited in the European search report is (are) enclosed as well.

The following specifications given by the applicant have been approved by the Search Division:

☒ abstract

☐ title

☐ The abstract was modified by the Search Division and the definitive text is attached to this communication.

The following figure will be published together with the abstract:

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REFUND OF THE SEARCH FEE

If applicable under Article 10 Rules relating to fees, a separate communication from the Receiving Section on the refund of the search fee will be sent later.





DOCUMENTS CONSIDERED TO BE RELEVANT

Category	Citation of document with indication, where appropriate, of relevant passages	Relevant to claim	CLASSIFICATION OF THE APPLICATION (Int.Cl.7)
X	US 6 564 055 B1 (HRONEK DANIEL J) 13 May 2003 (2003-05-13) * abstract * * column 1, line 31 - line 57 * * column 3, line 39 - line 60 * * column 4, line 44 - line 51 * * column 5, line 13 - line 34 *	1,12	H04Q7/24
A	* column 6, line 7 - line 32 * ---	2-11, 13-16	
A	EP 1 204 290 A (ERICSSON TELEFON AB L M) 8 May 2002 (2002-05-08) * abstract * * column 3, paragraph 10 - column 4, paragraph 13 * -----	1-16	
The present search report has been drawn up for all claims			TECHNICAL FIELDS SEARCHED (Int.Cl.7)
			H04Q
Place of search		Date of completion of the search	Examiner
THE HAGUE		17 March 2004	Larcinese, C
CATEGORY OF CITED DOCUMENTS			
X : particularly relevant if taken alone Y : particularly relevant if combined with another document of the same category A : technological background O : non-written disclosure P : intermediate document			
T : theory or principle underlying the invention E : earlier patent document, but published on, or after the filing date D : document cited in the application L : document cited for other reasons & : member of the same patent family; corresponding document			

**ANNEX TO THE EUROPEAN SEARCH REPORT
ON EUROPEAN PATENT APPLICATION NO.**

EP 03 02 0958

This annex lists the patent family members relating to the patent documents cited in the above-mentioned European search report. The members are as contained in the European Patent Office EDP file on
The European Patent Office is in no way liable for these particulars which are merely given for the purpose of information.

17-03-2004

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
US 6564055	B1	13-05-2003	AU
		WO	3285601 A
			0154435 A1
EP 1204290	A	08-05-2002	CN
			EP
			JP
			1352509 A
			1204290 A2
			2002171220 A



This application is covered by the extended European search report pilot project at present running within the European Patent Office, applied to all European patent applications filed as first filing and searched on or after 01.07.03. Under this project the EPO issues together with the search report an opinion on whether the application and the invention to which it relates meet the requirements of the EPC. This non-binding opinion is issued free of charge as a service. This opinion may be used as the basis for an informed decision as to whether it is desired to pursue the application further or not.

For further details of this pilot project, the applicant's attention is directed to the Official Journal edition 5/2003. If any further immediate questions or comments arise the EPO Customer Services: +31-70-340 4500 or +49-89-2399 2828 can be contacted.

The attached opinion reveals that the application or the invention to which it relates appear not to meet the requirements of the Convention (see comments on enclosed Form 2906).

If the applicant wishes to continue with this application the examination fee must be paid. Where appropriate amendments can be filed to address the objections raised in the opinion, thus shortening the overall procedure. If no amendments are filed, the opinion will be re-issued as the first official communication under Article 96(2) and Rule 51(2) EPC.

If the examination fee has already been paid and the right to the communication under Article 96(1) EPC has been waived for this application, the first official communication under Article 96(2) and Rule 51(2) EPC will be issued promptly.



The examination is being carried out on the **following application documents**:

Text for the Contracting States:

AT BE BG CH CY CZ DE DK EE ES FI FR GB GR HU IE IT LU MC NL PT RO SE SI SK TR LI

Description, pages:

1-11 as originally filed

Claims, No.:

1-16 as originally filed

Drawings, sheets:

1/4-4/4 as originally filed

The following document (D) is referred to in this communication; the numbering will be adhered to in the rest of the procedure:

D1: US-B1-6 564 055 (HRONEK DANIEL J) 13 May 2003 (2003-05-13)

1. The application does not meet the requirements of Article 84 EPC, because claims 1 and 12 are not clear.

1.1 Claims 1 and 12 have been drafted as separate independent claims.

Under Article 84 in combination with Rule 29(2) EPC an application may contain more than one independent claim in a particular category only if the subject matter claimed falls within one or more of the exceptional situations set out in paragraphs (a), (b) or (c) of Rule 29(2) EPC.



1.2 The formulation " In a system..., the mobile device..." used in the independent claim 12 does not allow the reader to clearly understand to which category said claim belongs to. Hence the requirements set in the Guidelines C-III-3.1 are not fulfilled. Claim 12 should be amended as follows: " **A mobile device...**"

2. Furthermore, the above-mentioned lack of clarity notwithstanding, the subject-matter of claims 1 and 12 is not new in the sense of Article 54(1) and (2) EPC, and therefore the requirements of Article 52(1) EPC are not met.

2.1 The document D1 discloses (the references in parentheses applying to this document):

a system for updating service information in a mobile communication device (column 1, lines 39-49) comprising
a provisioning server (*IRDB manager*, column 5, line 39) operable to receive a provisioning update request from the mobile communication device and in response to the provisioning update request transmit a service update data message to the mobile communication device (column 5, lines 13-20) the service update data message including service information for the mobile communication device that is received by the provisioning server from at least one of a plurality of service providers (column 6, lines 33-46);
wherein the mobile communication device is operable to detect a triggering event and transmit the provisioning update request to the provisioning server in response to the triggering event (column 5, lines 25-34)

The subject-matter of claim 1 is therefore not new (Article 54(1) and (2) EPC).

2.2 The considerations of point 2.1 also apply to the independent claim 12. The subject-matter of claim 12 is therefore not new (Article 54(1) and (2) EPC).

3. The subject-matter of claim 10 appears to be novel and inventive over the available prior art. Hence, the applicant should file a new system claim to render it more consistent with the corresponding method claim 10. The applicant should bear in mind that the features known in combination in D1 should be placed in the preamble of such a claim in accordance with Rule 29(1) EPC.



4. To meet the requirements of Rule 27(1)(b) EPC, the document D1 should be identified in the description and the relevant background art disclosed therein should be briefly discussed.
5. The features of the claims should be provided with reference signs placed in parentheses to increase the intelligibility of the claims (Rule 29(7) EPC). This applies to both the preamble and characterising portion (see the Guidelines, C-III, 4.11).
6. Independent claims 1,10 and 12 are not in the two-part form in accordance with Rule 29(1) EPC, which in the present case would be appropriate, with those features known in combination from the prior art (document D1) being placed in the preamble (Rule 29(1)(a) EPC) and with the remaining features being included in the characterising part (Rule 29(1)(b) EPC). Independent claims 1,10 and 12 should therefore be redrafted accordingly. If, however, the applicant is of the opinion that the two-part form would be inappropriate, then reasons therefor should be provided in the letter of reply. In addition, the applicant should ensure that it is clear from the description which features of the subject-matter of claims 1,10 and 12 are already known in combination from the document D1 (see the Guidelines, C-III, 2.3b).
7. The attention of the applicant is drawn to the fact that the application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

C.Larcinese